REMARKS

This document is submitted in response to the Advisory Action of August 23, 2006, and in connection with a Request for Continued Examination. Upon considering the foregoing claims and remarks, it is believed that the Examiner will agree that all claims patentably distinguish over the cited prior art and should be formally allowed.

A. Claims 1, 2, 28, 37, 29, 38, 32, 41, 42, 34, 43, 35, 44, 36, 45, 4, 5 and 7—10 are not anticipated by U.S. Patent 4,923,547 to Yamaji et al.

As originally presented, claim 1 reads on a conformable veil comprising a plurality of fibers having an average length of between approximately 0.5 and 2 meters. A polystyrene-based binder applied to the plurality of fibers is substantially soluble in a sheet molding compound resin paste. Claim 28 requires a conformable veil comprising *inter alia* a plurality of fibers having an average length of between approximately 0.5 and 2 meters. Claim 37 in turn requires a conformable veil comprising *inter alia* a plurality of fibers having an average length of between approximately 1 and 3 meters.

The Yamaji et al. reference allegedly anticipates the inventions of each of the foregoing claims. However, this reference explicitly teaches the use of monofilament fibers having a length of between 10 to 200 mm, or a maximum of 0.2 meters. In contrast, the inventions of claims 1, 28, and 37 all require a conformable veil comprising "a plurality of fibers having an average length of" between approximately 0.5 and 3 meters. Clearly, the explicit fiber length range taught in Yamaji et al. differs from and does not overlap with the average length range set forth in any of claims 1, 28, and 37. Thus, there can be no doubt that the Yamaji et al. reference fails to disclose all the claim elements and does not provide a proper basis for an anticipation rejection, which plainly requires that each and every element of a claimed invention be found in a reference exactly as required in the claim. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9

USPQ2d 1913, 1920-21 (Fed. Cir. 1989) ("anticipation" requires that the identical invention is described in a single prior art reference).

In fact, the Yamaji et al. reference fails to provide a proper basis for the rejection of claims 1, 28, or 37 under any basis. More specifically, it is a stated objective of Yamaji et al. to provide a lightweight composite molded article with excellent "moldability" (see col. 2 lines 36—40). In order to achieve this objective, this reference explicitly teaches that the fibers must have a length between 10 to 200 mm (see col. 2 lines 57—59, col. 3 line 65 to col. 4 line 2 and all the independent claims 1, 15, 22 and 27 of the Yamaji et al. reference).

In contrast, a primary goal of Applicant's invention is to provide a desired level of fiber entanglement to decrease fiber prominence at the visible surface of the composite part and thereby improve the smoothness of this surface. This entanglement also increases the loft of the formed parts (see paragraph 28 of the present application). The use of longer fibers in order to achieve these desirable benefits is simply neither taught nor suggested in Yamaji et al.. Quite the contrary, this reference actually leads one skilled in the art away from using fibers longer than 0.2 meters in length as such use adversely affects moldability. It is well established that it is error to find obviousness where the prior art relied upon diverges from and teaches away from the invention at hand. See *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983) and *In re Fine*, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988).

In point of fact, the modification proposed by the Examiner is contrary to the explicit teachings of Yamaji et al., which expressly sets forth and claims a maximum fiber length of 200 mm. By suggesting a modification requiring the use of fibers that are longer by at least two and as much as fifteen times greater than the maximum length taught in Yamaji et al., the Examiner's proposed modification essentially renders the Yamaji et al. reference unsatisfactory for its intended objective and purpose: that is, to provide an article with excellent "moldability". Where a proposed modification renders the prior art invention

being modified unsatisfactory for its intended purpose, it is well established there is no suggestion or motivation to make the proposed modification. See MPEP § 2143.01 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Thus, it is clear that the Yamaji et al. reference fails to provide any basis whatsoever for the rejection of independent claim 1 and claim 1 should be allowed.

Claims 2, 4, 5, and 7—10 which depend from claim 1 and are rejected on the same grounds are equally allowable for the same reasons. The same is true of dependent claims 29, 32, 34 and 36, which depend from claim 28, and dependent claims 38 and 41-45, which depend from claim 37.

B. Claims 3, 30 and 39 clearly patentably distinguish over the Yamaji et al. patent when considered in combination with U.S. Patent 4,579,774 to Kuwazuru et al.

As noted above, the primary reference to Yamaji et al. explicitly teaches that the fibers are limited to a maximum length of 200 mm in order to meet the objective and purpose of Yamaji et al. to provide the desired "moldability". The secondary Kuwazuru et al. reference explicitly teaches the use of fibers having a length of 0.01 to 30 mm (see col. 3 lines 28-31). Thus, both the primary reference to Yamaji et al. and the secondary reference to Kuwazuru et al. explicitly teach or suggest the use of fibers that are much shorter than those explicitly set forth in independent claims 1, 28 and 37 from which claims 3, 30 and 39, respectively, depend. Clearly both the primary and secondary references teach away from the present invention. Further, the proposed modification of the Examiner is absolutely contrary to the explicit teachings of Yamaji et al. relating to the maximum usable length of fibers in order to meet the explicit "moldability" objective of the Yamaji et al. patent. Thus, it is clear that claims 3, 30 and 39 patentably distinguish over this art and should be allowed.

C. Claims 31, 33 and 40 clearly patentably distinguish over the Yamaji et al. patent

Claims 31, 33, and 40 were not in any way rejected in the final Office Action of May 3, 2006, either in the listing of the claims or substantively. Instead of withdrawing the finality of the Office Action to present proper rejections, as is customary, the Examiner upon realizing this mistake issued an Advisory Action noting the "similar" nature of these claims to others in the case and thereby upholding their rejection. This practice is clearly contrary to the requirements of the MPEP, which expressly cautions against piecemeal examination and disfavors rejections that state "a mere conclusion coupled with some stereotyped expression." MPEP Section 707.07(g). Furthermore, these hasty, after final rejections leave Applicant unable to determine the basis for rejection (that is, anticipation or obviousness) and properly respond or appeal.

Nevertheless, Applicant reiterates the independent patentability of these claims over the Yamaji et al. reference, whether the rejection is sounded in anticipation or obviousness. As noted above, Yamaji et al. explicitly teaches the use of monofilament fibers having a length of between 10 to 200 mm, or a maximum of 0.2 meters. In contrast, the inventions of claims 31 and 40 require glass fibers having lengths of between 0.5 and 3 meters. Clearly, the explicit fiber length range taught in Yamaji et al. differs and does not overlap with the average length range set forth in these claims. Thus, Yamaji et al. fails to disclose the claimed glass fibers and cannot therefore properly anticipate or render obvious the invention of either claim 31 or claim 40.

Likewise, claim 33 depends from claim 28 and requires a veil that is compression molded with a binder substantially dissolved in a resin, and that the veil elongates such that the plurality of fibers of average lengths of between 0.5 to 3 meters have an average fiber diameter of between approximately 11 and 14 micrometers. Again, Yamaji et al. explicitly teaches the use of monofilament fibers having a maximum length of 0.2 meters. In contrast, the invention of claim

33 requires fibers having average lengths of between 0.5 and 3 meters, which is not disclosed, taught or even remotely suggested in Yamaji et al. Accordingly, the invention of claim 33 is not anticipated or rendered obvious.

In summary, all pending claims patentably distinguish over the prior art and should be formally allowed. Upon careful review and consideration it is believed the Examiner will agree with this proposition. Accordingly, the early issuance of a formal Notice of Allowance is earnestly solicited. Any fees required in connection with this Response may be debited to Deposit Account 50-0568.

Respectfully submitted,

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